

EXHIBIT 7



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**DIXIE USA, INC., a Texas corporation, and BUCHBOARD PATIENT
SHIFTERS, INC., a Texas corporation, Plaintiffs, v. INFAB CORPORATION, a
Delaware corporation, and DONALD CUSICK, an individual, and PICKER
INTERNATIONAL, INC., a New York corporation, Defendants**

Case No. CV 89-4396 SVW

**UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF
CALIFORNIA**

1990 U.S. Dist. LEXIS 15789; 16 U.S.P.Q.2D (BNA) 1392

February 15, 1990, Decided

February 26, 1990, Filed

CASE SUMMARY

PROCEDURAL POSTURE: Defendants filed a motion for summary judgment of non-infringement on the claims of patent infringement and inducing patent infringement.

OVERVIEW: Plaintiffs filed a patent infringement action against defendants. Plaintiffs argued that defendants' stretcher-type plastic board for carrying medical patients infringed plaintiffs' patent. Defendants argued that plaintiffs amended their patent claim regarding the handholds to overcome the prior art. Defendants claimed that this amendment, which narrowed plaintiffs' patent claim, estopped plaintiffs from recapturing what they gave up in obtaining their patent. The court agreed with defendants and estopped plaintiffs from arguing the doctrine of equivalents. The court balanced the equities and determined that application of prosecution history estoppel was appropriate because the equities did not tip in favor of plaintiffs.

OUTCOME: The court granted defendants' motion for summary judgment of non-infringement and dismissed plaintiffs' first two causes of action because no cause of action for infringement existed due to prosecution history estoppel.

CORE CONCEPTS

*Civil Procedure : Summary Judgment : Burdens of
Production & Proof*

*Civil Procedure : Summary Judgment : Summary
Judgment Standard*

Summary judgment is proper only where the pleadings, depositions, answers to interrogatories, and admission on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. Proc. 56(c). The moving party has the burden of demonstrating the absence of a genuine issue of fact for trial.

*Civil Procedure : Summary Judgment : Burdens of
Production & Proof*

A party opposing a properly supported motion for summary judgment must set forth specific facts showing that there is a genuine issue for trial. Fed. R. Civ. Proc. 56(e).

Patent Law : Infringement : Summary Judgment

*Patent Law : Infringement : Prosecution History
Estoppel*

In the area of patent law, summary judgment will be upheld where the claims do not read on the accused structure to establish literal infringement and a prosecution history estoppel makes clear that no actual infringement under the doctrine of equivalents can be found.

Patent Law : Infringement : Doctrine of Equivalents

To prevail under the doctrine of equivalents, a plaintiff must show that the accused item performs substantially the same function in substantially the same way to obtain the same result.

Patent Law : Infringement : Doctrine of Equivalents

In applying the doctrine of equivalents, each limitation must be viewed in the context of the entire claim. It is well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device.

Patent Law : Infringement : Prosecution History Estoppel

The doctrine of prosecution history estoppel is an equitable tool for determining the permissible scope of patent claims as against a specific structure accused of infringement. Claim amendments and arguments made during the prosecution for a patent may preclude a patentee from recapturing what was foregone during prosecution of the patent application.

Patent Law : Infringement : Prosecution History Estoppel

The doctrine of prosecution history estoppel prevents a patentee from enforcing its claims against otherwise legally equivalent structures if those structures are excluded by claim limitations added in order to avoid prior art.

Patent Law : Infringement : Doctrine of Equivalents

Patent Law : Infringement : Prosecution History Estoppel

The invocation of the doctrine of prosecution history estoppel does not automatically preclude the application of the doctrine of equivalents. That a patent applicant narrows his claim to secure a patent does not always mean that prosecution history estoppel completely prohibits the patentee from recapturing some of what was originally claimed. The amount of coverage retained depends on the circumstances of each case.

Patent Law : Infringement : Doctrine of Equivalents

Patent Law : Infringement : Prosecution History Estoppel

Both the doctrine of equivalents and the doctrine of prosecution history estoppel are equitable in nature, and require courts to engage in a balancing analysis guided by equitable and public policy principles underlying the doctrines involved and by the facts of the particular case.

JUDGES:

[*1]

Stephen V. Wilson, United States District Judge.

OPINIONBY:
WILSON

OPINION:

MEMORANDUM OPINION AND ORDER GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT

Plaintiffs' first amended complaint lists causes of action for patent Infringement, inducing patent infringement, unfair competition, and trademark infringement. Defendants Infab Corporation ("Infab"), Donald Cusick ("Cusick"), and Picker International ("Picker") now move for summary judgment of non-infringement on the claims of patent infringement and inducing patent infringement.

STATEMENT OF FACTS

Plaintiffs contend that Infab's stretcher-type plastic board for carrying medical patients infringes plaintiffs' Patent No. 4,067,079. Plaintiffs allege that Picker is a former distributor of plaintiffs' boards and that after the distributorship was terminated, Picker requested Cusick (president of Infab) to cause Infab to manufacture and sell to Picker copies of plaintiffs' patented board.

Plaintiffs' patent shows and describes a rectangular plastic board for carrying medical patients. The board has two kinds of openings adjacent to the periphery of the board. In the words of the patent, the board has

a plurality of openings in [*2] said slab and disposed adjacent the periphery of said support surface providing means for gripping the plastic slab to effect sliding movement of the plastic slab and the patient support thereon;

said plurality of openings comprising generally rectangular openings having rounded corners and rounded openings for grasping the slab for moving a patient;

said openings being disposed inwardly from the periphery of the slab a greater distance than the thickness of the slab.

The patent claim also states that a patient can be X-rayed through the board.

Defendants' accused board is also used for moving patients, is octagonal in shape, and allows for a patient to be X-rayed through the board. The accused board however, does not have any rounded openings; instead, all the openings are rectangular in shape.

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STANDARD OF REVIEW

Summary judgment is proper only where "the pleadings, depositions, answers to interrogatories, and admission on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. Proc. 56(c). The moving party has the burden of demonstrating the absence [*3] of a genuine issue of fact for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986). A party opposing a properly supported motion for summary judgment must set forth specific facts showing that there is a genuine issue for trial. Id.; Fed. R. Civ. Proc. 56(e).

In the area of patent law, "summary judgment will be upheld 'where the claims do not 'read on' the accused structure' to establish literal infringement 'and a prosecution history estoppel makes clear that no actual infringement under the doctrine of equivalents can be found.'" *Townsend Engineering Co. v. Hitec Co., Ltd.*, 829 F.2d 1086 (Fed. Cir. 1987) (quoting *Brenner v. United States*, 773 F.2d 306 (Fed. Cir. 1985); see D. Chisum, 4 Patents 18.06[2] n.1 (1989).

DISCUSSION

A. The Doctrine of Equivalents

Plaintiffs concede that there is no literal infringement of their patent. Instead, they argue that the accused board is infringing their patent under the doctrine of equivalents. To prevail under the doctrine of equivalents, the plaintiffs must show that the accused item "performs substantially the same function in substantially the same way to obtain the same result." *Mannesmann* [*4] *Demag Corp. v. Engineered Metal Prod.*, 793 F.2d 1279, 1283-84 (Fed. Cir. 1986), quoting *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 70 S. Ct. 854, 856 (1950). Furthermore, "in applying the doctrine of equivalents, each limitation must be viewed in the context of the entire claim. ... It is ... well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device." *Pennwalt Corp. v. Durand-Wayland Inc.*, 833 F.2d 931, 935 (Fed. Cir. 1987) (quoting *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528 (Fed. Cir. 1987).

In the case at bar, the Plaintiffs' patent has only one claim. Accordingly, the Plaintiffs must show the presence of every element or the substantial equivalent of every element of their patent claim in the Defendants' accused device. In comparing the accused board to the patented board, the boards are nearly identical except for the shape of the handholds. Plaintiffs naturally argue that

defendants' rectangular handholds are substantially equivalent to the rectangular and round handholds [*5] on the patented device.

B. Prosecution History Estoppel

Defendants contend that the doctrine of prosecution history estoppel prevents the Plaintiffs from arguing the doctrine of equivalents. The doctrine of prosecution history estoppel is "an equitable tool for determining the permissible scope of patent claims as against a specific structure accused of infringement." *Mannesmann*, 793 F.2d at 1284. Claim amendments and arguments made during the prosecution for a patent may preclude a patentee from recapturing what was foregone during prosecution of the patent application. *Black & Decker Inc. v. Hoover Service Center*, 886 F.2d 1285 (Fed. Cir. 1989). Thus, the doctrine of prosecution history estoppel prevents a patentee "from enforcing its claims against otherwise legally equivalent structures if those structures are excluded by claim limitations added in order to avoid prior art." *Mannesmann*, 793 F.2d at 1284.

The invocation of the doctrine of prosecution history estoppel however, does not automatically preclude the application of the doctrine of equivalents. *Black & Decker*, 886 F.2d at 1295. "That a patent applicant narrows his claim to secure a patent does not [*6] always mean that prosecution history estoppel completely prohibits the patentee from recapturing some of what was originally claimed. The amount of coverage retained depends on the circumstances of each case." *Pennwalt*, 833 F.2d at 939. Both doctrines are equitable in nature, and require courts to engage in a balancing analysis 'guided by equitable and public policy principles underlying the doctrines involved and by the facts of the particular case.' *Black & Decker*, 886 F.2d at 1295 (quoting *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 871 n.7 (Fed. Cir. 1985).

C. Plaintiffs' Prosecution History

Defendants argue that the plaintiffs amended their patent claim with regards to the handholds in order to overcome the prior art. Defendants claim that this amendment, which narrowed Plaintiff's patent claim, now estops Plaintiffs from recapturing what they gave up in obtaining their patent.

A review of the prosecution history reveals that Plaintiffs did indeed amend their patent claim with regards to the handholds. In their first patent application, Plaintiffs described the handholds as "a plurality of openings in said slab and disposed adjacent the periphery of said [*7] support surface providing means for gripping the plastic slab to effect sliding movement of

the plastic slab and the patient support thereon." The patent officer rejected Plaintiffs' patent application in its entirety. Referring to a prior patented device, the patent officer said the prior device "teaches a patient support made of plastic with hand holds for gripping when moving the patient to [sic] so modify the structure of A would be obvious to one familiar with the art and not patentable."

The Plaintiffs then amended the description of the handholds to read "said plurality of openings comprising generally rectangular openings having rounded corners and rounded openings for grasping the slab for moving a patient." In explaining this change to the patent officer, the Plaintiffs argued that none of the prior art "discloses the specific shape and location of the claimed rectangular and round openings." (emphasis in original). While the second application was also rejected by the patent officer, the third application, containing the same description of the handholds, was accepted.

Viewing the facts in a light most favorable to the Plaintiffs, the Court agrees with Defendants that [*8] the facts of this specific case require that Plaintiffs be estopped from arguing the doctrine of equivalents. During the prosecution of their patent, Plaintiffs took the position that the rounded handholds coupled with the rectangular handholds were different from a "plurality of openings" because none of the prior art "discloses the specific shape and location of the claimed rectangular and round openings." Now, Plaintiffs are attempting to argue that the plurality of openings on Defendants' accused board are substantially equivalent to the handholds on Plaintiffs' patented board. Once Plaintiffs took the position that their handholds were different in order to overcome the prior art, they cannot now recapture that which they sought to overcome.

D. Balancing of the Equities

The court is mindful that the doctrine of prosecution history estoppel should not be applied hypertechnically, but through a balancing of equities and public policy. Arguments favoring the Plaintiffs are the facts that the handholds may appear substantially equivalent to a layperson and that the Plaintiffs allege that Defendants literally copied Plaintiffs' manufactured board by tracing it from [*9] a catalog. However, the Court also notes that at one time Plaintiffs themselves argued that the handholds were not equivalent. Moreover, while Defendants may have traced a picture of Plaintiffs' manufactured board, the board that Plaintiffs manufacture is not the board as patented. n1 As patented, Plaintiffs' board is rectangular in shape with rectangular and round handholds. Plaintiffs' manufactured board is octagonal in shape and does not have any round

handholds. It is ironic that Plaintiffs argued that the round and rectangular handholds were an improvement over prior art and now do not even manufacture boards with the round handholds. In light of these facts, this Court does not believe that the equities tip in favor of Plaintiffs.

n1 At the summary judgment hearing, Plaintiffs displayed their manufactured board and the Defendants' accused board and asked the Court to make a comparison. The Court noted that while the boards appeared similar, Plaintiffs' board did not appear as it did in the patent drawings.

[*10]

CONCLUSION

After having reviewed the papers, declarations, exhibits, and oral argument, this Court holds that Plaintiffs are estopped from arguing the doctrine of equivalents with regards to the handholds. Since Plaintiff cannot then show that the handholds in Defendants' accused board are substantially equivalent to the handholds in Plaintiffs' patented board, no cause of action for infringement lies. Accordingly, Defendants' motion for summary judgment of non-infringement is GRANTED.

IT IS SO ORDERED.

SUMMARY JUDGMENT - February 26, 1990,
Filed

Pursuant to the Order filed February 16, 1989, it is hereby ORDERED, ADJUDGED, and DECREED that Defendants' motion or summary judgment of non-infringement is granted in full and Plaintiffs' first two causes of action are dismissed with prejudice as to all Defendants.

Pursuant to Federal Rule of Civil Procedure 54(b), this Court finds that there is no just reason for delay of an entry of final judgment as to the first two causes of action and hereby expresses the direction of the entry of judgment.

Plaintiffs have represented to the Court that in the event this Court is affirmed on appeal as to its summary judgment order, Plaintiffs will [*11] not pursue the remaining two causes of action. Pursuant to this representation, this Court orders the remaining two causes of action stayed pending the determination of any appeal of the summary judgment order.

IT IS SO ORDERED.